

Serial No.: 10/540,805

REMARKS

Applicants respectfully request reconsideration of this Patent Application, particularly in view of the above Amendment and the following remarks. No additional claim fee is required for this Amendment as the number of independent claims is not more than three, and the total number of claims is not more than twenty.

A Request for Continued Examination (RCE) and the required RCE fee are submitted herewith.

Request for Telephone Interview

Applicants kindly request the Examiner to contact the undersigned at (847) 490-1400 to schedule a telephone interview, to discuss the merits of this Patent Application.

Amendment to the Claims

Claims 1 and 19 have been amended to further describe the sealing element and its position within the cutting tool. New independent Claim 20 has been added and finds support in original Claim 1, the figures, and at page 11, second paragraph, of the Substitute Specification. No new matter has been added to the claims by this Amendment.

Claim Rejections - 35 U.S.C. §102

The rejection of Claims 1-19 under 35 U.S.C. §102(b) as anticipated by WO '238 is respectfully traversed.

WO '238 teaches a shoulder 4 resting against a seating surface 22, and a sealing ring 18 around the receptacle 11 opening. However, WO '238 does not teach a clearance forming an adjusting space between a shoulder of a base element and a side of a chisel holder, where a **thickened** portion of the sealing element bridges the clearance.

WO '328 does not anticipate Applicants' claimed invention because WO '328 teaches neither Applicants' recited clearance forming an adjusting space between the shoulder in a front part of the base element and the side of the chisel holder facing the shoulder, nor the recited sealing element partially closing the opening and having a thickened portion shaped to bridge the clearance. The sealing element of WO '328 is the same thickness throughout.

For at least these above reasons, favorable reconsideration and withdrawal of the rejection are respectfully requested.

New Claim 20 also recites a sealing element seated in a bezel and including a thickened portion extending out from the bezel and having a shape that bridges a clearance.

Serial No.: 10/540,805

Claim Rejections - 35 U.S.C. §102

The rejection of Claims 1-19 under 35 U.S.C. §103(a) as being anticipated by Wrulich et al., U.S. Patent 4,456,306 is respectfully traversed.

The Wrulich et al. Patent also does not teach a sealing element having a thickened portion for extending into and bridging a clearance between a shoulder of a base element and a side of a chisel holder, as in Applicants' claimed invention. The sealing element of the Wrulich et al. Patent has the same cross sectional thickness throughout.

For at least these reasons, the Wrulich et al. Patent does not anticipate Applicants' claimed invention.

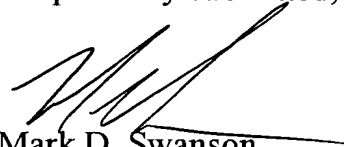
Conclusion

Applicants intend to be fully responsive to the outstanding Office Action. If the Examiner detects any issue which the Examiner believes Applicants have not addressed or resolved in this response, the undersigned attorney again requests a telephone interview with the Examiner.

Serial No.: 10/540,805

Applicants sincerely believe that this Patent Application is now in condition for allowance and, thus, respectfully request early allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'M. Swanson', with a long horizontal stroke extending to the right.

Mark D. Swanson
Regis. No. 48,498

Pauley Petersen & Erickson
2800 West Higgins Road, Suite 365
Hoffman Estates, Illinois 60169
(847) 490-1400
FAX (847) 490-1403